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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,031

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Cory Schaffhausen

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EXAMINER

BACHMAN, LINDSEY MICHELE

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

12/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,031	<b>Applicant(s)</b> SCHAFFHAUSEN, CORY	
	<b>Examiner</b> LINDSEY BACHMAN	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7, 20 and 22-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 33-37 is/are allowed.
- 6) ☒ Claim(s) 20-29 is/are rejected.
- 7) ☒ Claim(s) 30-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is response to Applicant's amendment filed 18 August 2008.

#### ***Information Disclosure Statement***

The information disclosure statement filed 28 December 2007 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. Cases not having an English abstract or translation are: citation numbers BB, BC, BD, BS, BT, BU, BV, BW, BX, BY, BZ, and CA. These references on the IDS submitted 28 December 2008 have not been considered.

#### ***Response to Arguments***

Applicant's arguments filed 18 August 2008 regarding the combination of Oberlander and Sikora are persuasive and therefore withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3734

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 20, 22, 23, 24, 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al. (US Patent Application 2003/0078617) in view of Sikora 2002/0019649.**

Claim 20, 23, 24, 27-29: Schwartz'617 teaches a method of repairing a tear in body tissue that includes ejecting a retaining head (18a) such that the retaining head lies against the outer surface of body tissue (54) (Figure 49) and also inserting an anchor (16) so that it is located between the tear and the outer surface of the body tissue (Figure 49). The retaining head and anchor are coupled by the terminal end of a flexible member (20) (Figure 49).

Schwartz'617 does not disclose how the retaining head and anchors are deployed.

Sikora'649 teaches a method of repairing a tear in a body tissue that includes a passing a needle (1070) from a first portion of the body tissue through the tear (1052) and to an outer surface of the body tissue (1058); ejecting a retaining head (1012) from the needle (1070) so that the retaining head (1012) lies against the outer surface (1058)

Art Unit: 3734

in an engaged position (paragraph [0152]); and inserting an anchor (1014) coupled to the retaining head (1012) (paragraph [0147], lines 1-2) by a flexible member (1016) from a first portion through the tear to a desired location (paragraph [0153]). Sikora'649 teaches advancing a plunger (1080) within the needle (1070) towards a distal opening of the needle (direction A, Figure 20), deploying the retaining head (1012) from the distal opening and removing the needle (1070) from the body tissue (paragraph [0152]). Sikora'649 teaches a slit (1076) and attaching the flexible member to an appendage of anchor that protrudes through the slit and holding it while releasing the anchor (paragraph [0146]). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art.

Claim 22: The flexible member of Schwartz is attached at only one location to the retaining head. Regarding the structure of the retaining head, anchor and their attachment to the flexible member: it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. The limitation of molding the flexible member to the anchor is a product-by-process limitation. The anchor/retaining head taught by Schwartz is the same product as claimed by Applicant (Figure 49).

**Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz'617 in view of Sikora'649, as applied to Claim 23, in further view of Clark (US Patent 5,954,747).**

Claim 25, 26: Schwartz'617 in view of Sikora'649 teaches the limitations of Claims 25 and 26 including meniscal repair. Schwartz in view of Sikora do not teach the use of a hollow tube that does not penetrate the tissue in order to deploy the anchor.

Clark'747 teaches that it is known to perform meniscal repair with an anchor (44) that is deployed from a hollow tube (54) having a blunt tip (64) and the blunt tip does not penetrate the meniscus (see Figures 10a-10f) because the blunt tip is used to push the meniscal tissue on opposite sides of the tear together without penetration (column 5, lines 15-18). It would have been obvious to modify the method taught by Schwartz in view of Sikora with the blunt end taught by Clark'747 because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art.

***Allowable Subject Matter***

Claims 1-7 and 33-37 are allowed.

The prior art does not teach the use of two tubular members in which the first is a needle that pierces the torn body tissue in order to deploy an anchoring device and the second is a blunt hollow member that does not penetrate the body tissue while

Art Unit: 3734

deploying a second anchoring device, in which the first and second anchoring devices are connected to one another.

Claims 30-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSEY BACHMAN whose telephone number is (571)272-6208. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. B./  
Examiner, Art Unit 3734

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773